

REMARKS**Status of the Claims**

Claims 1, 3-8, 10-14, and 16-20 were pending in the Application prior to this Response. In this response, claims 1, 8, 4, and 20 have been amended, claims 5, 11, and 18 have been canceled, and new claims 21-23 have been added. Claims 1, 3-4, 6-8, 10, 12-14, 16-17, and 19-23 are currently present in the Application, and claims 1, 8, and 14 are independent claims.

Examiner Interview

Applicants wish to thank Examiner Jeanty for the courtesy extended to Applicants' attorney during a telephone interview on September 20, 2006. During the interview, Applicants' attorney discussed claims 1 and 5 with regard to the cited prior art. As discussed in detail below, Applicants' attorney noted that the cited prior art does not disclose changing a surplus employee data record to a non-surplus employee data record. The Examiner suggested pulling some of the claim elements from dependent claim 5 into claim 1. The Examiner further noted that he would be performing a new search. No agreement was reached regarding the claims.

Claim Objections Under 35 U.S.C. § 112

Claims 1, 8, and 15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the term "high end" is not present in the specification. Applicants assume the Office Action meant to reject claims 1, 8, and 14, as claim 15 was canceled in a previous Response. Applicants have amended claims 1, 8, and 14 to clarify that the list of sorted employee data records is an ordered list, where the list is ordered according to the employee evaluations. Support for this amendment is found in Figure 26, reference numerals 2650 and 2660, and in the corresponding description of Figure 26, found in Applicants' specification on page 68, line 6 through page 69, line 27 (in particular, see page 69, lines 10-15). No new matter has been added as a result of these amendments.

Based on the amendments to claims 1, 8, and 14, Applicants respectfully request that the Examiner remove the objections under 35 U.S.C. § 112.

Claim Rejections – Alleged Obviousness Under 35 U.S.C. § 103

Claims 1, 3-8, 10-14, and 16-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Office of Personnel Management (OPM), Restructuring Information Handbook Module 3, Reduction in Force, June 1998 (hereinafter OPM), in view of “Corporate Downsizing: The Effect of Implementation Strategies on Firm Performance,” by Robert Nixon, Doctor of Philosophy thesis at Texas A&M University, December 1995 (hereinafter Nixon). Applicants respectfully traverse the rejections under 35 U.S.C. § 103.

Note that independent claim 1 has been amended to include limitations previously found in dependent claim 5, and therefore, claim 5 has been canceled. Similarly, independent claims 8 and 14 have been amended to include limitations previously found in dependent claims 11 and 18, respectively, and claims 11 and 15 have been canceled.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). OPM is a handbook used by the U.S. Office of Personnel Management in order to provide guidelines and information for reduction in force procedures. Nixon is a paper that discusses the effect of corporate downsizing strategies on firm performance (see Nixon, Abstract, page iii). Applicants respectfully submit that neither OPM nor Nixon, nor a combination of the two, teaches or suggests all the elements of Applicants’ independent claims, as amended.

Applicants teach and claim a method, information handling system, and computer program product for analyzing resources for a reduction action. Using claim 1

as an exemplary claim, Applicants' independent claims, as amended, include the following elements:

- identifying a skill group that includes surplus human resources;
- selecting one or more employees data records corresponding to the identified skill group;
- analyzing one or more evaluations corresponding to the selected employee data records;
- choosing a surplus group of employee data records from the selected employee data records based on the analysis, wherein the choosing includes:
 - sorting the selected employee data records by the evaluations, the sorting resulting in a list of sorted employee data records, wherein the list is ordered according to the evaluations;
 - receiving a surplus percentage corresponding to the skill group; and
 - selecting a number of the sorted employee data records by applying the surplus percentage to a low end of the ordered list of sorted employee data records;
- comparing the chosen surplus employee data records with non-surplus employee data records, wherein both the chosen surplus employee data records and non-surplus employee data records have a common skill group;
- identifying one or more of the surplus employee data records as non-surplus employee data records based on the comparison; and
- changing the identified surplus employee data records to non-surplus employee data records based on the identification.

The prior art does not teach many of the elements of Applicants' independent claims. Applicants respectfully submit that neither OPM nor Nixon teaches or suggests "receiving a surplus percentage corresponding to the skill group," and then "selecting a number of the sorted employee data records by applying the surplus percentage to a low end of the ordered list of sorted employee data records," as taught and claimed by Applicants. The Office Action states that OPM does not teach a surplus percentage, but then cites Nixon at page 36 as disclosing this aspect of Applicants' claims (see Office Action, page 4, line 17 through page 5, line 8). However, the cited section of Nixon (beginning on page 36 and continuing on through page 51) is a detailed discussion of using a low reallocation strategy versus a high reallocation strategy. A low reallocation strategy "requires all units to reduce personnel by an equal amount of a uniform percentage" (Nixon, page 36). A high reallocation strategy "is indicative of deep, selective or focused reductions targeted towards specific units, groups or functions" (Nixon, page 36).

Nixon's discussion of a low reallocation strategy versus a high reallocation strategy does not address, for either type of strategy, how the percentages are used to actually choose a group of surplus employee data records. Nixon's focus is on business units and not on how a surplus percentage would be applied to specific skill groups within a business unit. Nixon does not discuss skill groups and therefore does not disclose "receiving a surplus percentage **corresponding to the skill group**," as taught and claimed by Applicants. Nixon is not concerned with the actual details of applying a surplus percentage, rather, Nixon's focus is on whether or not the same percentage should apply to every business unit. Therefore, Nixon does not teach or suggest "**selecting** a number of the sorted employee data records **by applying the surplus percentage** to a low end of the ordered list of sorted employee data records," as taught and claimed by Applicants.

Based on the above discussion, Applicants respectfully submit that neither OPM nor Nixon teaches or suggests "receiving a surplus percentage corresponding to the skill group," and then "selecting a number of the sorted employee data records by

applying the surplus percentage to a low end of the ordered list of sorted employee data records,” as taught and claimed by Applicants in independent claims 1, 8, and 14.

Applicants further submit that neither OPM nor Nixon teaches or suggests “comparing the chosen surplus employee data records with non-surplus employee data records . . .,” “identifying one or more of the surplus employee data records as non-surplus employee data records based on the comparison,” and then “changing the identified surplus employee data records to non-surplus employee data records based on the identification.” These claim elements were originally present in dependent claims 5, 11, and 18. In the discussion of claims 5, 11, and 18, ***the Office Action does not even address the “identifying” and “changing” elements of these claims*** (see Office Action, page 6, line 11 through page 7, line 6). Therefore, as the Office Action does not provide any basis for rejecting these particular claim elements, Applicants respectfully submit that the claim elements are not found in the prior art, and the claims are therefore allowable.

The Office Action does discuss modifying the group of identified surplus employees based on a statistical analysis (see Office Action, page 7, lines 2-6). Applicants respectfully note that no statistical analysis is claimed in any of Applicants’ claims. Further, the section of OPM that is cited as disclosing “modifying” the group of identified surplus employees does not teach or suggest “changing the identified surplus employee data records to non-surplus employee data records based on the identification,” as taught and claimed by Applicants. The cited section of OPM, on page 13, discusses using a separate retention register for excepted employees. This is in direct contrast to Applicants’ invention, as claimed, where employees within a particular skill group are analyzed as a group. Applicants claim that a surplus employee data record may be ***changed*** to become a non-surplus employee data record, based upon a comparison. In OPM, it appears that some employees are never even considered for a reduction in force. These employees are considered “excepted” and are listed in ***separate*** retention registers. Therefore, they are never selected for a reduction in force

and there is no need to change them from a surplus designation to a non-surplus designation.

By using separate retention registers for excepted employees, OPM actually teaches away from Applicants' claims, where employees within a particular skill group are analyzed as a group, and then one or more of the surplus employee data records is **changed** to a non-surplus employee data record. Based on the above discussion, Applicants respectfully submit that none of the prior art, either alone or in combination, teaches or suggests "comparing the chosen surplus employee data records with non-surplus employee data records . . .," "identifying one or more of the surplus employee data records as non-surplus employee data records based on the comparison," and then "changing the identified surplus employee data records to non-surplus employee data records based on the identification," as taught and claimed by Applicants in independent claims 1, 8, and 14.

As discussed above, the prior art does not teach or suggest many of the elements claimed in independent claims 1, 8, and 14. Therefore, Applicants respectfully submit that independent claims 1, 8, and 14, and the claims which depend from them, are patentable over OPM in view of Nixon.

Notwithstanding the patentability of claims 3 and 16 based on the above discussion, Applicants would like to further discuss these claims. Applicants note that claims 3 and 16 add the element that "the skill group includes a skill level." For example, a skill group may be a programmer group, and a skill level may include a junior programmer designation. The Office Action cites OPM at page 11, section 5 as disclosing the elements of Applicants' claims 3 and 16 (see Office Action, page 5, lines 9-18). Applicants note that the elements discussed in this section of the Office Action are NOT the elements found in claims 3 and 16. There appears to be a typographical error in the Office Action with regard to claims 3 and 16. Furthermore, Applicants do not find anything in OPM or Nixon that discusses a skill group including a skill level, as taught and claimed by Applicants. Applicants respectfully submit that none of the prior art, either alone or in combination, teaches or suggests that "the skill group includes a

skill level,” as taught and claimed by Applicants in claims 3 and 16. Therefore, Applicants respectfully submit that claims 3 and 16 are patentable over the prior art, and respectfully request that they be allowed.

Claim 4 depends from independent claim 1 and is patentable for at least the reasons discussed above. Similarly, claims 10 and 17 depend from independent claims 8 and 14, respectively, and are also patentable for at least the reasons discussed above. Notwithstanding the patentability of claims 4, 10, and 17, Applicants would like to further discuss these claims. Using claim 4 as an exemplary claim, claims 4, 10, and 17 include the following additional elements:

- identifying an employee corresponding to one of the employee data records to evaluate;
- retrieving an evaluation template from a plurality of evaluation templates corresponding to the identified employee’s skill group;
- evaluating the identified employee using the retrieved evaluation template; and
- storing the identified employee’s evaluation in a data store stored on a nonvolatile storage area.

The Office Action cites OPM at page 11, section 5, page 12, section 6, and page 10, section f as disclosing these elements of Applicants’ claims (see Office Action, page 5, line 19 through page 6, line 10). Once again, Applicants note that the elements discussed in this section of the Office Action are NOT the elements found in Applicants’ claims 4, 10, and 17. It appears that there is another typographical error in the Office Action.

Applicants further submit that none of the prior art, either alone or in combination, discloses anything having to do with “retrieving an evaluation template,” “evaluating the identified employee using the retrieved evaluation template,” and then “storing the

identified employee's evaluation in a data store," as taught and claimed by Applicants in claims 4, 10, and 17. The sections of OPM cited in the Office Action have to do with grouping interchangeable positions into competitive levels based upon similarity of grade, series, qualifications, duties, and work tour, listing employees on a retention register in order of standing, and the possibility of reassigning an employee to another position. The Office Action does not provide any citations to any prior art that discloses evaluation templates, or anything related to the elements found in claims 4, 10, and 17. Therefore, Applicants respectfully submit that claims 4, 10, and 17 are patentable over the prior art, and respectfully request that they be allowed.

New Claims 21-23

New claims 21-23 depend from independent claims 1, 8, and 14, respectively, and are therefore allowable for at least the reasons discussed above with regard to the independent claims.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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